

## **REMARKS/ARGUMENTS**

### **The Status of the Claims.**

Claims 1-74 are pending with entry of this amendment. Claims 75-89 are currently withdrawn from consideration as a non-elected restriction group. Claim 1 is amended herein. This amendment introduces no new matter and support is replete throughout the specification. The amendment is made without prejudice and is not to be construed as abandonment of the previously claimed subject matter or agreement with any objection or rejection of record.

With respect to claim 1, support for transport of sample holders between devices and work perimeters can be found throughout the specification. For example, see Figures 1 and 3, and the Work Perimeters section starting on page 14 of the specification.

Applicants submit that no new matter has been added to the application by way of the above Amendment. Accordingly, entry of the Amendment is respectfully requested.

### **Copyright Notification.**

There was not a public use, sale or publication of inventions claimed before the filing of the present application. The copyright notification on page one of the application is solely intended to provide notification of rights retained by the Applicants under 37 § 1.71(e).

### **35 U.S.C. §102.**

Claims 1-3, 9-11, 13, 19-20, 22-23, 36-37, 42-43, 57-61, and 66-73 were rejected under 35 U.S.C. §102(b) as allegedly anticipated by Sato. Applicants traverse.

In order for a reference to anticipate an invention, anticipation requires that “all limitations of the claim are found in the reference, or ‘fully met’ by it.” Kalman v. Kimberly-Clark Corp., 218 USPQ 781, 789 (Fed. Cir. 1983). With regard to amended claim 1 and associated dependent claims, not all limitations are described in Sato.

In Sato, a technician hand loads sample cups **22** [sample holders] into a sample carrying rotary disk **2**; there they remain. Individual sample holders are never

transported between two or more devices or to devices in two or more work perimeters during operation of the system, as is required, e.g., in clause (d) of the present claim 1. Sato fails to describe these necessary limitations of claim 1 and thus Sato can not anticipate claim 1 or any of the dependent claims. Applicants request that the section 102 rejections of claims based on Sato be withdrawn.

**35 U.S.C. §103(a).**

Claims 1-74 were rejected under 35 U.S.C. §103(a) as allegedly obvious based on Hutchins in view of Ishibashi; and based on Amano in view of Kedar, Ishibashi, and Stylli. Applicants traverse.

Three requirements must be met for a *prima facie* case of obviousness. First, the prior art reference must teach all of the limitations of the claims. M.P.E.P. § 2143.03. Second, there must be a motivation to modify the reference or combine the teachings to produce the claimed invention. M.P.E.P. § 2143.01. Third, a reasonable expectation of success is required. M.P.E.P. § 2143.02. The teaching or suggestion to combine and the expectation of success must be both found in the prior art and not based on Applicants' disclosure. M.P.E.P. §2143.

Specifically, a *prima facie* case of obviousness requires that the combination of the cited art, taken with the general knowledge in the field, must provide all of the elements of the claimed invention. When a rejection depends on a combination of prior art references, there must be some teaching, suggestion or motivation to combine the references. In re Geiger, 815 USPQ2s 1276, 1278 (Fed. Cir. 1987). Moreover, to support an obviousness rejection the cited references must additionally provide a reasonable expectation of success. In re Vaeck, 20 USPQ2d 1438 (Fed. Cir. 1991), citing In re Dow Chemical Co., 5 USPQ2d 1529, 1531 (Fed. Cir. 1988).

**The claims are not obvious based on Hutchins in view of Ishibashi.** The combined references fail to provide all the limitations of the present claims.

The Examiner, at the end of the first paragraph of page 5 in the Office Action, alleges that Hutchins teaches all limitations of all claims except the "non-sequential treatment of the samples." This is not the case. Hutchins teaches a series of work stations 18 each

including a "robotic device **23** individually associated with each of the units [devices] **12**" (see column 3, line 65, emphasis added). Hutchins does not describe all the limitations of claim 1, clause (b), e.g.: at least one device associated with each work perimeter, and at least one work perimeter with two or more devices exclusively within reach of the rotational robot. The device bypassing conveyor belts described in Ishibashi also fail to describe the clause (b) limitations. Because the cited combination fails to teach all the limitations of the claims, the section 103 rejection based on Hutchins in light of Ishibashi must be withdrawn.

Moreover, there is no motivation to combine the teachings of Hutchins and Ishibashi. A specific suggestion to make such a combination does not exist in the specification of either reference. Furthermore, inclusion of the conveyor and bypass systems of Ishibashi would require a change in the basic sequential module and rotary robot principle of operation found in Hutchins. It is well established that if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959). As in *In re Ratti*, the suggested combination of references here would require a substantial reconstruction and redesign of the elements shown in Hutchins as well as a change in the basic principle under which the Hutchins apparatus was designed to operate. Therefore, the cited combination of references does not render Applicants' claims *prima facie* obvious.

**The claims are not obvious based on Amano in view of Kedar, Ishibashi or Stylli.** The combined references fail to provide all the limitations of the present claims. Moreover, there exists no motivation to combine the teachings of the cited references.

Amano describes a robot **20** that can transport a sample tube **37** [sample holder] between devices in an analytical system (see Figure 2). The Examiner suggests that Amano does not teach a plurality of modules, multi-well plates as sample holders or non-sequential treatment of the samples, as set forth in certain dependent claims, as discussed below. In addition, as noted above, Amano fails to teach the claim 1, clause (d) limitations of transporting an individual sample holder to at least one device in each of at least two rotational robot work perimeters. Nothing in the Kedar, Ishibashi or Stylli references provides these missing elements.

Kedar teaches a single rotational robot transporting multiwell plates between devices. Kedar does not provide the claim 1 limitations missing from Amano. For example, Kedar does not teach transporting an individual sample holder to at least one device in each of two or more rotational robot work perimeters. Furthermore, Kedar does not teach required limitations found in the several dependent claims concerning multi-well plates, such as, e.g., the alternate sample holders of claim 13; the multiple dispensing device of claim 29; pin tool devices of claims 31 and 32; inner wall alignment members and pushers of claims 50-52; and, the multi-well lid of claim 54. Kedar in combination with Amano fails to teach all the limitations of claim 1, or any of the dependent claims. Therefore this combination does not render any of the claims obvious.

The Examiner again cites Ishibashi as allegedly teaching parallel or serial transfer of cups to a module without respect to the order in which the cups were supplied. However, this does not provide the basic elements of claim 1, e.g., transporting an individual sample holder to at least one device in each of at least two rotational robot work perimeters. Therefore, a combination of Amano with Ishibashi does not render any of the claims obvious.

Stylli teaches queuing of sample holders and handling of multiple samples at multiple individual work stations. The Examiner states that one of ordinary skill in the art would know to incorporate the parallel processing of Stylli into the Amano apparatus to operate each module efficiently and reduce wasted time. As with the Ishibashi reference, incorporation of parallel processing does not provide the missing limitations of, e.g., independent claim 1. The combination of Amano and Stylli does not teach, e.g., transporting an individual sample holder to at least one device in each of at least two rotational robot work perimeters (whether this is accomplished in series or parallel is irrelevant, e.g., to claim 1). A combination of Amano with Stylli does not teach all the limitations of the claims and does not render any of the claims obvious.

In addition, the cited references do not provide motivation to one of ordinary skill in the art to combine the teachings to make the invention claimed by Applicants, as is required to make a case for obviousness. The references do not themselves teach or suggest the cited combinations. The Examiner has proposed (second paragraph of page 10) that

motivation for one skilled in the art to combine the parallel processing of Ishibashi or Stylli with the Amano apparatus would be a reduction in wasted time. However, this motivation is not set forth by the art, and the combination of references does not provide the claimed inventions.

Moreover, to combine the teachings in the cited references would require substantial reconstruction and redesign of the elements shown in Amano, as well as a change in the basic principle under which the Amano construction was designed to operate. The invention of Amano is based on the basic principle that a robot associated with a series of devices can speed sequential processing and analysis of samples. In Amano, repetitive pretreatments of samples in preparation for injection into an inherently sequential HPLC column for analysis is speeded by robotic processing of the samples through consecutive assay steps. To incorporate suggested aspects (e.g., bypass conveyors, linear robots, massively parallel sample handling) of the cited references to Amano would necessarily change the principle of operation. Thus, the inventions claimed by Applicants can not be considered obvious.

Because the present claims are not obvious in view of cited combinations of art, Applicants respectfully request that the rejections of claims based on section 103 be withdrawn.

### **CONCLUSION**

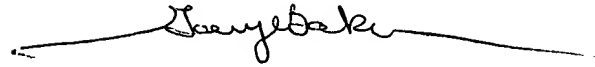
In view of the foregoing, Applicants believes all claims now pending in this application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the claims are deemed not to be in condition for allowance after consideration of this Response, a telephone interview with the Examiner is hereby requested. Please telephone the undersigned at (510) 769-3510 to schedule an interview.

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Amdt. Dated January 14, 2005  
Reply to Office action of September 16, 2004

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Respectfully submitted,

A handwritten signature in black ink, appearing to read "Gary Baker", is written over a horizontal line.

Gary Baker  
Reg. No: 41,595

Attachments:

- 1) A transmittal sheet;
- 2) A receipt indication postcard.
- 3) A request for extension of time

Office Action response HTP.doc